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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/776,247 | 02/12/2004 | Alain A. Meilland | 006450-369 | 4511 |

21839 7590 05/26/2006

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EXAMINER

LOCKER, HOWARD J

ART UNIT PAPER NUMBER

1661

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/776,247 | Applicant(s) MEILLAND, ALAIN A. | |
| | Examiner Howard J. Locker | Art Unit 1661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) remains rejected under 35 U.S.C. 102(b) as the instant plant 'Meivaleir' was described in the following printed publications more than one year prior to the first date of application for Plant Patent for same (August 21, 2001) in the United States (parent application 09/933174):

FR PBR 0163545 (published April 10, 1997), which matured into Grant/Reg. Number 11226 (published December 10, 1999) (denomination accepted on July 10, 1997 and denomination published April 10, 1997); or

QZ PBR 980546 (published on June 15, 1998), which matured into Grant/Reg. Number 4990 (published on December 15, 1999) (denomination accepted on October 4, 1999);

taken in view of the admission that "***Plants of the 'Meivaleir' variety were made available to the public in France during September 1998***" and the MEILLAND RICHARDIER catalog excerpt (August 1998) submitted by applicant as Exhibit F in the papers filed March 23, 2003 (in parent application serial number 09/933174), which per applicant's admission "***was made available to others in France and identifies the 'Meivaleir' variety***".

NOTE: This rejection was previously set forth in the Office action mailed September 06, 2005. Applicant's March 17, 2006 response has been considered but is not found persuasive to overcome the rejection of record.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, f.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ-2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP 2121.03.

It has been determined, and explicitly conceded on the record by applicant, that the above publicly available publications disclose the claimed plant variety and that said claimed variety was placed on public sale more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published applications, published grants, and accepted/published denominations, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant. Information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The admission of prior sale and offer for sale more than one year prior to the filing date of the instant application enables the referenced documents because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation in the Genus *Rosa*, as evidenced by the cited Huxley, et al. excerpt, for example at page 112. See also, e.g., *Thomson*, supra. See also Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16 (August 2000), Clark, Boardman, Callaghan (*"In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public."*). Contrary to applicant's continuing arguments, and for the reasons stated herein, such would indeed have enabled the skilled artisan to have reproduced the instant cultivar more than one year prior to applicant's effective filing date.

Arguments set forth relative to limited number of 'Meivaleir' plants made available; that said limited number of 'Meivaleir' plants were made available in a limited area of the world; and that said limited number of 'Meivaleir' plants were made available in a limited area of the world with limited publicity have been considered. However, rather than support applicant's position, the specifics as set forth in applicant's March 17, 2006 response go to support the fact that the plant was indeed known and available and that such public availability/sale was not an isolated, solitary occurrence that would go unnoticed by those skilled in the art.

For example, the limited area of the world is set forth in applicant's arguments as being "primarily France", the limited number of plants prior to August 21, 2000 is set forth as being "approximately 15,000", with these plants being available to growers in France, Germany, and Italy (page 7 of applicant's response). The limited publicity is at the very least approximately 100,000 catalogs (page 6 of applicant's response) with applicant stating that said catalogs were "*distributed among some amateur rose growers solely within the country of France more than one year prior to the August 21, 2001 effective filing date of the present application*" for United States Plant Patent.

This statement, even if true, would not support that this was an isolated, obscure or solitary occurrence that would go unnoticed. Additionally, not referenced in applicant's comments/arguments is that the catalog/information would also have been available through/over the internet, or that once the paper catalogs were out of applicant's hands, they were out of applicant's control per se as well.

Thus, applicant's statement that the August 1998 catalog Meilland Richardier was limited to amateur rose growers in France is unfounded. The argument that said availability in "primarily in France" would have gone unnoticed by the rest of the world where the vast majority of rose growers reside is not supportable.

Arguments as to the populations of France, Germany, and Italy as compared to the population of Europe or the plant earth per se are not persuasive, as given the above admissions and facts, the plant was indeed known and publicly available and such public availability/sale was not an isolated, solitary occurrence that would go unnoticed by those skilled in the art. The above numbers and facts simply do not support this contention.

Contrary to applicant's assertions, the facts in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states "The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record..." 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere. Applicant LeGrice never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Brief, Appendix B, pages 10-11). It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection.

The LeGrice Court noted that "...only an 'enabling' publication is effective as a bar to a subsequent patent. We do not agree with the view expressed by the examiner that this necessarily requires that plant publications be 'totally ignored.' " 133 USPQ at 374. The LeGrice Court concluded, "The mere description of the plant is not necessarily an 'enabling' disclosure." 133 USPQ at 378. In the instant application, there is more than a "mere description" of the plant – there is also evidence of public availability of the same more than one year before the instant application was filed. The claimed plant is within the "knowledge of those skilled in the art" by virtue of its public availability. One skilled in the art would thus have known "how to make" the claimed plant upon reading the cited publications, by purchasing a clone of the plant and asexually propagating it by cuttings or any other known method in the art. Thus, the publications provide an enabling disclosure when combined with the knowledge of the skilled artisan.

As stated during the prosecution of the parent application and in the previous Office action, the examiner agrees that the publication "by itself" would not enable a person skilled in the art to reproduce the claimed plant. However, the availability of the plant whether through sale or other form of public availability would enable the disclosure of the printed publication.

The contention of record in the parent application that foreign commercial availability or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...". There is no geographic limitation of the bar under 35 U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on foreign published documents ("printed publications"), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

That the claimed plant was not available in the United States more than one year prior to the date of domestic filing is not relevant to patentability, as there is no geographic component of enablement. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* 10 USPQ2d 1719, 1720 (Bd. Pat. App. & Inter. 1989), where a specification was found to be enabling even though the required biological material was not deposited, but was obtainable from specified locations in the ocean (specifically, only off the coast of Central and South America, as described in U.S. Patent 4,548,814, col. 1, lines 43-60).

Therefore, a foreign disclosure describing the claimed subject matter, published over a year prior to the filing of the domestic application, is an enabling bar under 35 U.S.C. 102(b) where the plant stock necessary for the publication could have been obtained over a year prior to the domestic filing of an application.

The argument set forth by applicant that there has been a misapplication of the law and that the *Thomson* decision is not in accordance to the law for the instant application as the *Thomson* application was drawn to a utility patent is not persuasive as *In re LeGrice*, 35 U.S.C. 161, and 36 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to plant patents except for the one exception set forth in 35 U.S.C. 162.

The rationale as set forth per se above has been found proper by the United States Court of Appeals for the Federal Circuit in its August, 2004 decision in the *Elsner* (03-1569) and *Zary* (03-1585) cases, even though these cases were remanded by the CAFC for further fact finding relating to the accessibility of the foreign sales of the claimed plants.

Given the information presented by applicant responsive to the Requirement made under 37 CFR 1.105, such has been determined NOT to be an obscure, solitary occurrence what would have gone unnoticed by those skilled in the art.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

3. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdprac.htm>

Art Unit: 1661

4. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

5. Applicant's response to the 06 September 2005 (remailed on 20 September 2005) Requirement for Information under 37 CFR 1.105 is deemed sufficient.

6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Anne Marie Grunberg, can be reached at 571-272-0975.

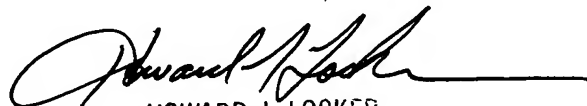
Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number for official correspondence is 571-273-8300.

Howard J. Locker/hjl

May 24, 2006


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661